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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,222

09/10/2003

Roger Morris

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EXAMINER

BEISNER, WILLIAM H

ART UNIT

PAPER NUMBER

1744

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/659,222

Applicant(s)

MORRIS ET AL.

Examiner

William H. Beisner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 17-49 and 53-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 50-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/8/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, Claims 1-16 and 50-52, in the reply filed on 12/26/06 is acknowledged.
2. Claims 17-49 and 53-58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/26/06.

Information Disclosure Statement

3. The information disclosure statement filed 3/8/2004 has been considered and made of record.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-4, 7, 8, 11, 14, 16, 50 and 52 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Freadman et al.(US 6,589,761).

With respect to claim 1, the reference of Freadman et al. discloses a device for detecting a presence of bacteria in a perishable food product that includes a gas-permeable sensor housing (16) and a pH indicator (14) within the housing for detecting a pH change which is indicative of the presence of bacteria. The pH indicator (14) being safe for human consumption (See column 3, line 44, to column 11, line 13).

With respect to claim 2, the indicator can exhibit a radiative change (See column 4, lines 9-19).

With respect to claim 3, the radiative changes indicated would be detectable by visual or optical detection devices.

With respect to claim 4, the indicators listed in the reference include indicator compositions that change color commensurate with pH change.

With respect to claim 7, the housing (16) is affixable to the food package interior (12) by mechanical or chemical means (See column 3, lines 9-16).

With respect to claim 8, part of the housing is transparent (See column 3, lines 27-28).

With respect to claim 11, the reference discloses the use of agar (See column 3, lines 46-54).

With respect to claim 14, the housing is capable of being positioned in the manner recited in the claim (See column 3, lines 9-16).

With respect to claim 16, the indicator can be an irreversible change (See column 4, line 16).

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With respect to claim 50, the method of making the button or wafer (See column 3, lines 14-16) would meet the method steps required of claim 50.

With respect to claim 52, the indicator can be an irreversible change (See column 4, line 16).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freadman et al.(US 6,589,761) in view of Shurben (US 4,960,565).

The reference of Freadman et al. has been discussed above.

Claim 5 differs by reciting that the device includes a reference element.

The reference of Shurben discloses that the use of color references with respect to optical detection elements is known in the art (See the abstract).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the device of the primary reference with a reference color for the known and expected result of providing a means recognized in the art for allowing the user to verify the color change of the test device.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freadman et al.(US 6,589,761) in view of Shurben (US 4,960,565) taken further in view of Perlman et al.(US 4,526,752).

The combination of the references of Freadman et al. and Shurben have been discussed above.

Claim 6 differs by reciting that the color changing element of the device provides a warning icon.

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The reference of Perlman et al. discloses that it is known in the art to provide a test element (13) as a warning icon (See Figure 2). The reagent composition is used with reference background on element (13).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a warning icon in the device of the modified primary reference for the known and expected result of confirming a positive result to the user of the device.

11. Claims 9, 10, 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Freadman et al.(US 6,589,761) in view of Wolfbeis et al.(US 5,407,829).

The reference of Freadman et al. has been discussed above.

Claims 9, 10, 12 and 13 differ by reciting that the pH indicator is encapsulated with silicone.

The reference of Wolfbeis et al. discloses that it is conventional in the art to encapsulate an indicator composition within a silicone material (See Figure 2 and Example 1).

In view of this teaching, it would have been obvious to one of ordinary skill in the art to encapsulate the pH indicator of the primary reference with silicone for the known and expected result of providing a means recognized in the art for isolating a pH composition within a housing to be used within a food package.

12. Claims 15 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freadman et al.(US 6,589,761) in view of Royce (US 3,000,706).

The reference of Freadman et al. has been discussed above.

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While the reference of Freadman et al. discloses the use of a housing that includes one gas permeable surface, the instant claims differ by reciting that the housing or sensor material has opposing first and second surfaces that can be exposed to the environment to be monitored.

The reference of Royce discloses that it is known in the art to provide pH sensitive indicators within a housing made of gas permeable material. The device includes opposing surfaces that are capable of being exposed to the environment to be monitored (See Figure 1).

In view of this teaching and in the absence of a showing of criticality and/or unexpected results, it would have been obvious to one of ordinary skill in the art to provide the pH indicator of the primary reference within a housing as disclosed by the reference of Royce for the known and expected result of providing an alternative means recognized in the art to achieve the same result, exposing a sensing device to the gas environment of a sealed vessel or container.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-16 and 50-52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-24 of copending Application No. 10/799,312. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-15 are generic to all that is recited in claims 20-21 of U.S. Application No. 10/799,312. With respect to claims 50-52, making the device as encompassed by claims 20-21 of '312 would have encompassed the steps required of instant claims 50-52 and would have been within the purview of one having ordinary skill in the art with making a device of the structure required of claims 20-21 of '312.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Beisner whose telephone number is 571-272-1269.

The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:15am to 3:45pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys J. Corcoran can be reached on 571-272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William H. Beisner
Primary Examiner
Art Unit 1744

WHB